

2000. No claims have herein been amended, canceled or added. Therefore, claims 25-28 and 53-71 remain in this case.

Applicants respectfully request reconsideration and withdrawal of the grounds of rejection and objection.

35 U.S.C. §102 Rejection

The Office Action rejected claims 25, 26, 53 and 60-71 under 35 U.S.C. §102(e), as allegedly anticipated by Yamakoshi et al. (U.S. Patent No. 5,600,501). Applicants respectfully, but most strenuously, traverse this rejection.

Claim 25 recites a method for correcting for systematic errors in the writing of timing patterns on a storage medium by a head of a recording device. The method comprises detecting one or more circumferential systematic errors, and correcting for the one or more circumferential systematic errors.

Applicants submit that Yamakoshi et al. cannot disclose either step of claim 25, since Yamakoshi et al. fails to disclose circumferential systematic errors.

As set forth in the present specification at, for example, page 5, lines 11-12, "circumferential systematic errors" are described as systematic errors that vary circumferentially. Further, systematic errors are described in the specification as errors that are fairly constant at a given radial position, i.e. from radial step to radial step. In other words, circumferential systematic errors are fairly constant from track to track, but vary from sector to sector. See, e.g., page 4, lines 12-19 of the present specification. This is borne out further in the specification by, for example, an index (i) indicating one value of circumferential systematic error per sector.

In stark contrast, the error addressed in Yamakoshi et al. is clearly radial in nature; that is, it varies from track to track, rather than sector to sector. See Yamakoshi et al. at, for example, column 12, lines 17-29.

cites to no specific section of Yamakoshi et al. for this proposition. Thus, Applicants submit that claim 26 cannot be anticipated thereby.

As another example, with respect to claims 65 and 71, the Office Action alleges at page 2, section 3 that "correction of the systematic errors as taught [by Yamakoshi et al.] inherently would correct at least some random errors that occur[.]" However, Applicants respectfully point out that since a systematic error is repeatable and non-random in nature, corrections therefor are not designed or intended to correct random errors. That a random error could possibly be corrected under certain circumstances upon correction of a systematic error is itself a randomly occurring event or simply a coincidence.

Moreover, the doctrine of inherency is well-settled in patent law, and is best described in an excerpt from Hansgird v. Kemmer, 26 C.C.P.A. 937, 102 F.2d 212, 40 U.S.P.Q. 665 (1939):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [citations omitted.] If, however, the disclosure [of the cited reference] is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient [to anticipate the claimed invention].

Id. at 940, 102 F.2d at 214, 40 U.S.P.Q. at 667; Stoller v. Ford Motor Co., 18 U.S.P.Q.2d 1545, 1547 (Fed. Cir. 1991); Tyler Refrigeration v. Kysor Industrial Corporation, 227 U.S.P.Q. 845, 847 (Fed. Cir. 1985); Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990); In re Oelrich and Divigard, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

In Ex parte Levy, the court stated that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings

of the applied prior art." Ex parte Levy, 17 U.S.P.Q.2d at 1464 (lengthy citation omitted) (underlining added).

Applicants submit that the required basis is simply absent from the Office Action. Therefore, Applicants submit that claims 65 and 71 cannot be anticipated by Yamakoshi et al.

35 U.S.C. §103 Rejection

The Office Action also rejected claim 57 under 35 U.S.C. §103, as allegedly obvious over Yamakoshi et al. Applicants respectfully, but most strenuously, traverse this rejection.

Claim 57 recites a storage device, comprising a storage medium, and a head radially positioned by an actuator, the head instructed to write a self-servo timing pattern on the storage medium. Systematic error are eliminated and a trajectory of the self-servo timing pattern matches a trajectory traced out by the head in its radial motion across the storage medium.

The Office Action fails to identify in Yamakoshi et al., or even mention, the claim language regarding the trajectories. Applicants submit that this omission fails to create even a prima facie case of obviousness. Moreover, Applicants submit that Yamakoshi et al. simply does not address that aspect of claim 57.

Therefore, Applicants submit that claim 57 cannot be obvious over Yamakoshi et al.

Objection to Claims

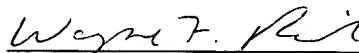
The Office Action objected to claims 27, 28, 55, 56, 58 and 59 as depending from rejected base claims. However, the Office Action also indicated that these claims would be allowable if rewritten in independent form, including all of the limitations of the relevant base claim and any intervening claims.

In response, Applicants sincerely appreciate the indication of allowable subject matter. In light of the remarks made above with respect to the rejected claims, Applicants respectfully decline at this time to so amend the noted claims. However, Applicants reserve the right to so amend claims 27, 28, 55, 56, 58 and 59 at a later time.

CONCLUSION

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly requests allowance of claims 25-28 and 53-71.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.



Wayne F. Reinke

Attorney for Applicants

Registration No.: 36,650

Dated: March 27, 2002.

HESLIN ROTHENBERG FARLEY & MESITI P.C.

5 Columbia Circle

Albany, New York 12203-5160

Telephone: (518) 452-5600

Facsimile: (518) 452-5579